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OFFICE OF PETITIONS

In re Patent No. 7,775,388 :
Murrer et al. : DECISION ON
Issue Date: August 17, 2010 : REQUEST FOR
Application No. 10/629,322 : RECONSIDERATION OF
Filed: July 28, 2003 : PATENT TERM ADJUSTMENT
Attorney Docket No. 034827-3101 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. §1.705," filed August 10, 2010, requesting that the patent term adjustment determination for the above-identified patent be changed from seven hundred and ninety-one (791) days to one thousand, eight hundred, and two (1802) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by nine hundred and one (901) days is **GRANTED to the extent indicated herein.**

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

On August 17, 2010, the above-identified application matured into US Patent No. 7,775,388 with a patent term adjustment of 791 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 C.F.R. § 1.705(d).

Patentee requests recalculation of the patent term adjustment to include a 901-day period of adjustment pursuant to 37 C.F.R. § 1.702(e), and argues that the Office erred in "not crediting the full period of appellate review."¹

¹ Petition, page 2.

The period of adjustment of 423 (414 + 9) days of examination delay is not in dispute.

The period of reduction of 93 (1 + 2 + 90) days of Applicant delay is not in dispute.

The nine-day period of overlap between the examination delay and the B-delay is not in dispute.

The fact that this patent issued three years and 1481 days after the filing of the application is not in dispute.

The sole item that is in dispute is the effect of the Appellate period of review on the patent term.

The relevant events are as follows:

- On May 5, 2006, a final rejection was mailed, which indicated, *inter alia*, that claims 6-10, 12-19, and 25 were rejected;
- On August 7, 2006, a Notice of Appeal was filed;
- On September 30, 2008, the Board of Patent Appeals and Interferences (Board) mailed a decision which affirmed the Examiner's rejection of claims 6-10, 12-19, and 25;
- On December 1, 2008, Applicant requested reconsideration of the aforementioned decision;
- On January 23, 2009, the Board mailed a Decision on the Request for Reconsideration which affirmed the rejection of claims 6-10, 12-16, and 25. The rejection of claims 17-19 was not affirmed. However, the Board rejected claims 17-19 under a new ground of rejection. No allowable claims remained in the application after this decision by the Board.
- On March 20, 2009, in response to the January 23, 2009 Board decision, Applicant submitted an amendment to the claims and remarks.

Patentee argues that since the Examiner's rejection of claims 17-19 was not affirmed by the Board in the decision mailed January 23, 2009, and the Board raised new grounds of rejection for these claims in this decision, the appellate review was successful within the meaning of 37 C.F.R. § 1.702(e), and the

entire period of appellate review constitutes examination delay pursuant to this Rule.²

The Office holds that the appellate period of review does not give rise to examination delay. Moreover, it is not included in the period of B delay.

37 C.F.R. § 1.702(e) sets forth, *in toto*:

Delays caused by successful appellate review. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued under a decision in the review reversing an adverse determination of patentability. If an application is remanded by a panel of the Board of Patent Appeals and Interferences and the remand is the last action by a panel of the Board of Patent Appeals and Interferences prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision by the Board of Patent Appeals and Interferences as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii), a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii), and a final decision in favor of the applicant under § 1.703(e). A remand by a panel of the Board of Patent Appeals and Interferences shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

37 C.F.R. § 1.703(a)(5) sets forth, *in toto*:

The period of adjustment under § 1.702(a) is the sum of the following periods:

(5) The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first; and

² Petition, pages 2 and 4.

37 C.F.R. § 1.703(b)(4) sets forth, *in toto*:

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

The period of Appellate review does not give rise to examination delay pursuant to 37 C.F.R. § 1.702(e) because the appeal was not successful, and the Board did not find in favor of the Applicant: the final office action of May 5, 2006 indicated that claims 6-10, 12-19, and 25 were rejected, and the January 23, 2009 decision on the Request for Reconsideration indicated that each of these claims remained rejected. As such, an adjustment to the patent term is not warranted under 37 C.F.R. § 1.702(e).

Moreover, the Decision on the Request for Reconsideration did not indicate that at least one allowable claims remains in the application. As such, an adjustment to the patent term is not warranted under 37 C.F.R. § 1.703(a)(5).

Finally, pursuant to 37 C.F.R. § 1.703(b)(4), the appellate period (which commenced subsequent to the commencement of the over-three year period) is not included in the period of B delay. A notice of appeal was filed on August 7, 2006, and the Board mailed a decision in response to the request for reconsideration on January 23, 2009. The 901 days of the over three-year period consumed by appellate review, beginning on August 7, 2006 and ending on January 23, 2009, are not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii).

As such, the patent term adjustment is increased by 901 (423 days of examination delay plus 580 (1481 over three-years minus

the aforementioned excluded appellate period of 901 days) B delay minus 93 days of Applicant delay minus 9 days of overlap) days, not 1802 days.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **nine hundred and one (901) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,775,388 B2

DATED : August 17, 2010

DRAFT

INVENTOR(S) : Murrer

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 791 days

Delete the phrase "by 791 days" and insert – by 901 days--